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SR

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/768,567 01/24/01 WALKER

J 96-001XX

022927
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QM22/0706

EXAMINER

SAGER, M

ART UNIT

PAPER NUMBER

3713

3

DATE MAILED:

07/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/768,567

Applicant(s)

Walker et al

Examiner

Sager

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 24, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 105-123 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 105-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).



MARK SAGER
PRIMARY EXAMINER

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps for exchanging information between controller and player, the information being exchanged while the player participates in a game of the tournament and influencing game play and storing player information in a database, as claimed (clms 105-114) and the steps for first and second sets of players playing in respective first and second games of a first round of competition and corresponding subsets being determined and arranged to compete in a second round as consistent with elimination tournament play, as claimed (clms 115-123) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 114 and 123 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the medium 'storing instructions to be executed by a processor to conduct a distributed electronic tournament' is a preamble recitation that does not breath life and meaning into the claims. Further, the medium is a storage medium storing code that is not implemented in a processing device which is non-statutory subject matter. The phrase in the preamble is not definitively claimed and thus is not implemented in the processing device. The PTO web site at <http://www.uspto.gov/web/patents/guides.htm> provides

guidance for claiming inventions relating to program code in Examination Guidelines for
Computer-Related Inventions & Training Materials.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 105-123 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 5779549 and claims 1-51 of U.S. Patent No. 6224486. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to claim the method or apparatus or medium broader in order to obtain the most commercially viable form of invention or in order to obtain the broadest protection for invention for securing commercial viability.

Essentially, the omitted language pertaining to storing player information associated with the player 'generated as the player participates in a game of the tournament' limited the invention to only data/information generated while the player played in the tournament and thus could not be general or personal data gathered before or after play of a game. Therefore, by omitting the cited language, a broader form of invention is claimed which secures broader protection for commercial

viability. Additionally, steps for round scheduling in an elimination tournament are well known and deemed obvious to add to a method for conducting a tournament such as Walker's so as to add a great deal of excitement due to using an elimination format (as admitted by Applicants, 5:24) and to automate the tournament management and ease administration thereof as a result thereby reducing the number of personnel and costs associated therewith necessary to administer the competition.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 115-116 and 118 are rejected under 35 U.S.C. 102(a) as being anticipated by instant background disclosure. Applicant's admitted prior art disclosed in instant background disclosure (2:10-6:20) teaches claimed steps since the claimed method is performing steps of elimination rounds (inherent thereto or by definition thereof) of a skill tournament such as conducted in skill competition (5:16-6:20). An elimination type tournament inherently includes first and second sets of players playing in respective first and second games of a first round of competition and corresponding subsets being determined and arranged to compete in a second round, as claimed, which steps are the definition of an elimination format competition. Claimed steps read on any skill tournament with elimination format, such as USCF, NBA, NFL, NHL,

tennis, golf, bowling, auto racing or any other skill competition with elimination of player(s) or team(s) based on performance of play.

8. Claims 115-116, 118, 121-123 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sabaliauskas (5359510). Sabaliauskas discloses a tournament management system for games of skill involving single or double elimination formats clearly teaching claimed steps, as broadly claimed.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 119-120 are rejected under 35 U.S.C. 102(a) as being anticipated by or in the alternative, under 35 U.S.C. 103(a) as being obvious over instant background disclosure.

Admitted prior art cited in instant background comprises all claimed steps for elimination competition (*supra*), and further comprises a player providing entry fee payments so as to fund the

tournament admin costs and seed the prize to attract players and for at least one player to receive a prize based on game play so as to attract players to the tournament and to reward the player(s) for winning/placing in tournament.

Alternatively, background does not definitively disclose the player(s) providing the entry fee payments (clm 119) and at least one player to receive a prize based on game play (clm 120). It is extremely well known for player(s) or team(s) of player(s) to provide entry fee payments to participate in tournaments or competitions so as to fund the tournament's administration costs and to seed the prize(s) and additionally, it is extremely well known for a player to receive a prize based on game play so as to reward the player(s) for their performance(s) and to attract players to the tournament with offer of prize, money or trophy to top performers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add 'provide entry fee payments' and 'receive a prize based on game play' as well known to instant background disclosure of elimination tournament play so as to fund the tournament or competition, to seed the prize(s), to reward the player(s) for their performance(s) and to attract players to the tournament with offer of prize, money or trophy for top performance(s).

12. Claims 117 and 121-123 are rejected under 35 U.S.C. 103(a) as being unpatentable over instant background disclosure. Admitted prior art cited in instant background discloses claimed steps as broadly claimed (supra), but fails to disclose the skill game being 'trivia' (clm 118) and the particular means or structure to implement the steps of method being software or code implemented in a computer or processor. Regarding trivia, the particular game of skill fails to patentably distinguish over other games of skill. The differences between the particularly claimed

game of skill and that which is disclosed/suggested by Applicant's admitted prior art for tournaments including elimination rounds in instant disclosure pertains to the game being trivia. Competitions for games of skill including trivia tournaments are known as admitted prior art in cited instant disclosure. Also, admitted prior art cited in instant background (3:15-4:27) states trivia competitions with player(s) providing fee payments and at least one player being awarded a prize conducted by game software implemented in processor or computing device are known. Additionally, the tournament format being an elimination with successive rounds of play for winning player(s) until tournament winner(s) is determined is known as admitted prior art by cited instant disclosure. Elimination format adds a great deal of excitement as admitted by Applicants (5:29). Therefore, it would have been obvious to add 'trivia' as a known game of skill to admitted prior art in instant disclosure to add a great deal of excitement to a trivia competition.

Regarding features of claims 121-123, using programmed code implemented in computers or processors to automatically perform previously labor intensive manually conducted steps of a method such as setup, organization and round scheduling for competition determination (who will play whom) in tournaments is well known so as to ease administration of tournament management. The admitted prior art does not state that the league or tournament organizers of the elimination rounds of the tournaments use particular means as programmed code implemented in processor or computing device to perform the steps of tournament management automatically so as to assist in the setup, organization or round scheduling for competition determinations (5:23-6:20). It would have been obvious to an artisan at the time the invention was made to add claimed means of programmed code implemented in a processor to conduct elimination rounds of

a skill tournament as known to admitted prior art cited in instant background so as to ease administration activities and reduce labor costs.

13. Claim 117 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sabaliauskas (5359510). Sabaliauskas discloses a tournament management system for organizing competition rounds within an elimination format in a skill tournament comprising claimed steps (*supra*) except trivia. Regarding trivia, the particular game of skill fails to patentably distinguish over other games of skill. The differences between the particularly claimed game of skill and that which is taught by Sabaliauskas pertains to the particular game being trivia. Competitions for games of skill including trivia tournaments are known. Trivia competitions with player(s) providing fee payments and at least one player being awarded a prize with tournament conducted by game software implemented in processor or computing device are known. Additionally, the tournament format being an elimination with successive rounds of play for winning player(s) until tournament winner(s) is determined is known. The elimination format in a skill competition is known to add a great deal of excitement. Therefore, it would have been obvious to add 'trivia' as a known game of skill to Sabaliauskas's tournament management to add a great deal of excitement to a trivia competition.

14. Claims 119-120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabaliauskas (5359510) in view of Thacher et al (5083271). Sabaliauskas discloses a tournament management system for organizing competition rounds within an elimination format in a skill tournament comprising claimed steps (*supra*) except provide entry fee payments (clm 119) and receive a prize based on game play (clm 120). Thacher discloses a tournament method for games

of skill teaching arranging to provide entry fee payments (2:40-66; 3:21-37; 4:9-19; 6:38-43) to fund prizes and receive a prize based on game play (6:26-37; 8:19-35; 19:1-7) to reward players and to attract them to play. Therefore, it would have been obvious to an artisan at the time the invention was made to add to provide entry fee payments and to receive a prize based on game play as taught by Thacher to Sabaliauskas' tournament to fund prizes, to reward players and to attract players to the tournament.

15. Claims 105-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thacher et al (5083271) in view of either Liverance (5370399) or instant background disclosure. Thacher discloses a method or apparatus or medium for playing games of skill (1:8-11; 2:5-7) in a distributed tournament (figs. 1-4) teaching a processor 6 with a storage device 6A which is in communication with the processor (fig. 1) storing instructions for executing steps: exchanging information between a central controller 6 and a player located remotely from the central controller 2, 8 being exchanged while the player plays a game in the tournament (2:12-28; 3:1-3; 15:20-25, 34-37), storing in a database player information associated with the player, the stored player information being available for use in a subsequent tournament (2:40-66; 3:21-37; 6:38-43), arranging to provide payment of an entry fee by determining a payment identifier associated with the player and wherein the player information is associated with the payment identifier (2:40-66; 3:21-37; 4:9-19; 6:38-43) and arranging for the player to receive a prize based on game play (6:26-37; 8:19-35; 19:1-7), but does not disclose or suggest the information 'influencing game play' (clms 105, 112-114). Liverance discloses an apparatus having an incentive producing means for games of skill or quiz or chance teaching adjusting difficulty level of game play for

'influencing game play' so as to maintain player interest in playing and thereby increase revenue through players' extended game play (1:58-2:2; 2:17-5:52; 7:27-34:20, esp. 2:52-65). Therefore, it would have been obvious to an artisan at the time the invention was made to add 'influencing game play' as taught by Liverance to Thacher's game or central computer so as to maintain player interest in playing and thereby increase revenue through players' extended play.

Alternatively, the admitted prior art cited in instant background suggests exchanging information between a central controller and a player located remotely from the central controller (player/participant in communication with AOL game site of NTN Communications' trivia game, 4:3-8), the information being exchanged while the player plays a game in the tournament (4:6-8) since the information being passed is both the players response to communicated questions and the time for player to respond with the adjustment in score 'influencing game play' by scoring players who respond faster with a larger portion of the points for each question, but with a smaller portion for those players who respond slower or with incorrect responses. This methodology assists in determining the best player(s) since the best player(s) will not only respond with the correct response, but will also be the fastest. Thacher discloses the tournament including games of skill and trivia games are games of skill. Therefore, it would have been obvious to an artisan at the time the invention was made to add a trivia game with 'influencing game play' as disclosed by Applicant's background to Thacher's tournament system to include an alternate methodology which assists in determining winners based upon player performance. It is noted that all skill-based games are scored based on player performance and the trivia game aforementioned is

another known methodology for scoring a player's performance which is deemed as an obvious alternative for assisting in determining a winner of a competition.

16. Applicant's arguments with respect to claims 105-123 have been considered but are moot in view of the new ground(s) of rejection. Examiner notes preliminary filed amendment fails to present rationale for claimed invention to be patentable in that no remarks to such were included.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin-Wallace, can be reached on (703) 308-4119. The fax phone number for Group 3300 is (703) 305-3580. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. Sager
Primary Examiner
June 28, 2001

Attachment for PTO-948 (Rev. 03/01, or earlier)
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.